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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,595	11/26/2003	Masatomo Matsubara	325772033300	5975

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EXAMINER
RUDOLPH, VINCENT M

ART UNIT	PAPER NUMBER
2625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/721,595	MATSUBARA ET AL.
Office Action Summary	Examiner	Art Unit	
	Vincent Rudolph	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>17 January 2008</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-17</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>26 November 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-4, 8 and 11-14 are rejected under 35 U.S.C. 102(a) as being

anticipated by Umebayashi ('765).

Regarding claim 1, Umebayashi ('765) discloses an image forming apparatus

(input device, **See Figure 1, Element 10**) that includes a holding portion (buffer, **See**

Figure 1, Element 7) holding obtained image data (stores the digitized image data, **See**

Col. 4, Line 21-23), an image-related information producing portion (attribute

information generating means, **See Figure 1, Element 3**) producing image-related

information related to the image data, which includes attribute information of the image

data (**See Col 4, Line 23-30**), an accepting portion (publication means, **See Figure 1,**

Element 6) accepting designation of a destination of the image-related information to be

sent (accepts a request to transmit the attribute table to the browser unit, **See Col. 5,**

Line 8-10), a sending portion (through the communication processing means, **See**

Figure 1, Element 5) sending the image-related information to an external device at the

designated destination (the attribute information list is transmitted to the user to view,

See Figure 18(b); Col. 7, Line 10-13), a receiving portion (through the communication

processing means, **See Figure 1, Element 5**) receiving output form instruction

information related to the image data from the external device (selects the image data to be printed and transmits the print request to the publication means, **See Col. 5, Line 27-38**), and an image forming portion (image data output means, **See Figure 1, Element 1a**) forming image data for outputting from the image data held by the holding portion based on the output form instruction information (once the image data is fetched, the image data is printed, **See Col. 5, Line 42-46**).

Regarding claim 2, Umebayashi ('765) discloses the image-related information producing portion produces the image-related information including an abbreviated image prepared from at least a part of the image data (a thumbnail image of the image data is generated, **See Col. 7, Line 21-26**).

Regarding claim 3, Umebayashi ('765) discloses the receiving portion receives, as an output form, the output form instruction information instructing the print output of the image data (receives an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Regarding claim 4, Umebayashi ('765) discloses the image data is obtained by scanning each document forming a document group (places the manuscripts to be inputted as image data by a scanner, **See Col. 4, Line 8-10**), the image-related information producing portion produces the image-related information for each document (generates the attribute information of the image data, **See Col. 4, Line 23-30**), and the receiving portion receives the output form instruction information instructing an output form for each of the documents (receives an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Regarding claim 8, Umebayashi ('765) discloses an image forming method that

includes a storing step for storing the obtained image data in a storage device by an

image forming apparatus (stores the digitized image data, **See Col. 4, Line 21-23**), an

image-related information producing step of producing image-related information related

to the image data in the image forming apparatus, which includes attribute information

of the image data (**See Col 4, Line 23-30**), a designating step of designating to the

image forming apparatus, a destination for the image-related information to be sent

(accepts a request to transmit the attribute table to the browser unit, **See Col. 5, Line 8-

10**), an image-related information sending step for sending the image-related

information to an image managing apparatus at the designated destination from the

image forming apparatus (the attribute information list is transmitted to the user to view,

See Figure 18(b); Col. 7, Line 10-13), an image-related information displaying step for

displaying in the image managing apparatus, the image-related information received

from the image forming apparatus (**See Figure 18(b)**), an output form instruction

producing step of producing in the image managing apparatus, output form instruction

information related to the image data (selects the image data to be printed, **See Col. 5,

Line 27-32**), an output form instruction information sending step of sending the output

form instruction information from the image managing apparatus to the image forming

apparatus (transmits the print request to have the image data outputted, **See Col. 5,

Line 33-38**), and an image forming step of forming the image data for output from the

image data stored in the storage device based on the output form instruction information

(once the image data is fetched, the image data is printed, **See Col. 5, Line 42-46**).

Regarding claim 11, Umebayashi ('765) discloses an image managing apparatus (browser unit, **See Figure 1, Element 30**) that includes a receiving portion (communication processing means, **See Figure 1, Element 34**) for receiving image-related information related to image data from the image forming apparatus (connects to receive the image attribute information, **See Col. 5, Line 6-11**), a display portion (display means, **See Figure 1, Element 31**) displaying the image-related information (**See Figure 18(b)**), an output form instruction information producing portion (embodied within the browser unit) producing output form instruction information instructing an output form of the image data held in the image forming apparatus based on the image-related information (user selects the image data to be outputted, **See Col. 5, Line 22-32**), and a sending portion (through the communication processing means, **See Figure 1, Element 34**) sending the output form instruction information to the image forming apparatus (transmits a printing request for the selected image data, **See Col. 5, Line 33-38**).

Regarding claim 12, Umebayashi ('765) discloses the image-related information includes an abbreviated image prepared from at least a part of the image data (a thumbnail image of the image data is generated, **See Col. 7, Line 21-26**), the display portion displays at least the abbreviated image (**See Figure 18(d)**), and the image managing apparatus further includes an accepting portion accepting the instruction operation using the abbreviated image and performed by a user for an output form (user selects the image data to be printed, **See Col. 5, Line 27-32**, using the thumbnail image, **See Col. 7, Line 38-40**).

Regarding claim 13, Umebayashi ('765) discloses that the output form instruction information producing portion produces as an output form, the output form instruction information instructing the print output of the image data (transmits an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Regarding claim 14, Umebayashi ('765) discloses the image data is obtained by scanning each document forming a document group (places the manuscripts to be inputted as image data by a scanner, **See Col. 4, Line 8-10**), the image-related information received from the image forming apparatus includes the image-related information for each document (generates the attribute information of the image data, **See Col. 4, Line 23-30**), and the output form instruction information producing portion produces an output form for each of the documents (transmits an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-7, 9-10 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umebayashi ('765) in view of Phillips (Pub. # 20040205504).

Regarding claim 5, Umebayashi ('765) discloses an image forming apparatus (input device, **See Figure 1, Element 10**) that includes a holding portion (buffer, **See Figure 1, Element 7**) holding obtained image data (stores the digitized image data, **See**

Col. 4, Line 21-23) and a sending portion (through the communication processing means, **See Figure 1, Element 5**) sending the abbreviated image to the external device (the thumbnail image is sent and displayed on the browser unit, **See Col. 7, Line 38-39**).

Umebayashi ('765) does not disclose an accepting portion that accepts a setting from an external device, such that the setting is related to an abbreviated image prepared from the image data, and an abbreviated image producing portion producing the abbreviated image by using a part of the image data based on the setting.

Phillips (Pub. # 20040205504) discloses an accepting portion (change request, **See Figure 1, Element 130**) accepting a setting from an external device (client send a user change request to the server, such as a configurations change, **See Page 2, Paragraph 0027**), and an abbreviated image producing portion (server change response, **See Figure 1, Element 160**) producing the abbreviated image by using at least a part of the image data based on the setting (sends the change back to the client for processing, **See Page 2, Paragraph 0027**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a setting for an abbreviated image and producing it, such as the one disclosed within Phillips (Pub. # 20040205504), and incorporate it into the image forming apparatus of Umebayashi ('765) because it allows the user to modify a selected image received rather than only being able to view it.

Regarding claim 6, the combination of Umebayashi ('765) and Phillips (Pub. # 20040205504) discloses that the accepting portion accepts the setting designating a

resolution of the abbreviated image (resolution of the thumbnails, **See Phillips (Pub. #**
20040205504), Page 3, Paragraph 0037).

Regarding claim 7, the combination of Umebayashi ('765) and Phillips (Pub. #
20040205504) discloses that the setting accepted by the accepting portion from the
external device designates at least one of change of the abbreviated image and
resending of the abbreviated image (client sends a change request and receives it in
response in order for the client to process the received configurations change, **See**
Phillips (Pub. # 20040205504), Page 2, Paragraph 0027).

Regarding claim 10, Umebayashi ('765) discloses an image forming method that
includes a storing step for storing the obtained image data in a storage device by an
image forming apparatus (stores the digitized image data, **See Col. 4, Line 21-23**), and
a first abbreviated image producing and sending step of producing a first abbreviated
image using a part of the image data and sending it to the image managing apparatus
(the thumbnail generated, **See Col. 7, Line 30-33**, is transferred to the browser unit to
be displayed, **See Figure 18(d); Col. 7, Line 38-39**).

Umebayashi ('765) does not disclose an instructing step of sending an instruction
related to the first abbreviated image from the image managing apparatus to the image
forming apparatus, and a second abbreviated image producing and sending step for
producing in the image forming apparatus, a second abbreviated image to be
substituted for the first abbreviated image using the image data and sending the image.

Phillips (Pub. # 20040205504) discloses an instructing step of sending an
instruction related to the first abbreviated image from the image managing apparatus to

the image forming apparatus (the client transmits a change request related to the thumbnails from the client computer to the server, **See Figure 1; Page 2, Paragraph 0027**), and a second abbreviated image producing and sending step for producing in the image forming apparatus, a second abbreviated image to be substituted for the first abbreviated image using the image data and sending the image (the server retrieves the image data corresponding to the change request and sends the change to the client computer for processing, **See Page 2, Paragraph 0027**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a sending an instruction for an abbreviated image and producing it, such as the one disclosed within Phillips (Pub. # 20040205504), and incorporate it into the image forming apparatus of Umebayashi ('765) because it allows the user to modify a selected image received rather than only being able to view it.

Regarding claim 15, Umebayashi ('765) discloses an image managing apparatus (browser unit, **See Figure 1, Element 30**) that includes a receiving portion (through the communication processing means, **See Figure 1, Element 34**) receiving an abbreviated image produced by using at least a part of the image data from an image forming apparatus (receives a thumbnail image data of the image data stored to be displayed, **See Figure 18(d); Col. 7, Line 38-39**).

Umebayashi ('765) does not disclose a sending portion sending instruction information providing an instruction related to reproduction of an abbreviated image concerning the abbreviated image to the image forming apparatus.

Phillips (Pub. # 20040205504) discloses a sending portion (embodied within the client, **See Figure 1, Element 100**) for providing an instruction related to reproduction of an abbreviated image concerning the abbreviated image to the image forming apparatus (a request to change configurations of the image data to the server, **See Page 2, Paragraph 0027**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a sending an instruction for reproducing an abbreviated image, such as the one disclosed within Phillips (Pub. # 20040205504), and incorporate it into the image forming apparatus of Umebayashi ('765) because it allows the user to modify a selected image received rather than only being able to view it.

Regarding claim 16, the combination of Umebayashi ('765) and Phillips (Pub. # 20040205504) discloses that the instruction related to the abbreviated image instructs at least one of change of the abbreviated image and resending the abbreviated image (client sends a change request and receives it in response in order for the client to process the received configurations change, **See Phillips (Pub. # 20040205504), Page 2, Paragraph 0027**).

Regarding claim 17, the combination of Umebayashi ('765) and Phillips (Pub. # 20040205504) discloses that the instruction related to the abbreviated image instructs the resolution of the abbreviated image (resolution of the thumbnails, **See Phillips (Pub. # 20040205504), Page 3, Paragraph 0037**).

Regarding claim 9, the rationale provided in the rejection of claim 5 is incorporated herein. In addition, the image forming apparatus of claim 5 corresponds to the image forming method of claim 9 and performs the steps disclosed herein.

Response to Arguments

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new grounds of rejection. Thus, the prior art of Umebayashi and Phillips is used and do meet the limitations of the amended claims as disclosed within the rejection above.

Based on these facts as well as having the applicant's arguments been fully considered and persuasive, **THIS ACTION IS MADE NON-FINAL.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

<div style="text-align:right">

Vincent Rudolph
Examiner
Art Unit 2625

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/Vincent Rudolph/
Acting Examiner of Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625